

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 10/805,695

Group Art Unit: 1794

Filed: March 22, 2004

Examiner: Steven N. Leff

Applicant: Paul V. Greco

Attorney Docket: Greco-001

Title: Weighted Infusion
Beverage Package

Commissioner for Patents
Alexandria, VA 22313

Sir:

APPLICANT'S REPLY BRIEF

This Reply Brief is timely and responds to the Examiner's Answer of July 22, 2008. No fees are enclosed herewith. If any additional fee is due, please charge the fee to deposit account no. 07-1732.

TABLE OF CONTENTS

I. Status of the Claims	3
II. Grounds of Rejection to be Reviewed on Appeal	4
III. Argument.....	5-15
IV. Claims Appendix.....	16-18

I. Status of the Claims

This application was filed with claims 1-20. Claims 6-9 have been cancelled. All remaining claims (claims 1-5 and 10-19) stand finally rejected. The final rejection of claims 1-5 and 10-19 was appealed on April 9, 2008. Therefore, claims 1-5 and 10-19 are the claims on appeal.

II. Grounds of Rejection to be Reviewed on Appeal

The issues on appeal are:

(1) whether claims 1-5, 10-13, and 18-19 are unpatentable under 35 U.S.C. §103(a) as obvious over Arcari (GB 2247001) in view of Kasket (3257212) and further in view of Kim (6221309) and in view of the "Tea Rock" teabag weight (www.mightybeancoffee.com March 2004);

(2) whether claim 14 is unpatentable under 35 U.S.C. §103(a) as obvious over Arcari (GB 2247001) in view of Kasket (3257212) and further in view of Kim (6221309), in view of the "Tea Rock" teabag weight (www.mightybeancoffee.com March 2004), and in view of Luckhaupt (2193974); and

(3) whether claims 15-17 are unpatentable under 35 U.S.C. §103(a) over Arcari (GB 2247001) in view of Kasket (3257212) and further in view of Kim (6221309), in view of the "Tea Rock" teabag weight (www.mightybeancoffee.com March 2004), and in view of Rambold (3542561).

III. Argument

Applicant maintains the arguments asserted in its Brief On Appeal with regard to the patentability of independent claim 1 and dependent claims 2-5 and 10-19, and hereby incorporates these arguments by reference in their entirety. The following arguments respond to the specific assertions raised by the Examiner's Answer to Applicant's Brief On Appeal.

Reply to Examiner's Response to Argument A.I.

In response to Applicant's argument that Arcari does not disclose a porous body portion carrying infusion beverage product in addition to a weight made from ceramic, porcelain, and/or naturally-occurring rock material as required by Claim 1, the Examiner's Answer essentially asserts that (1) Applicant's cancelled claim 8 and Applicant's specification teach that the weight may comprise a dissolvable agent, and thus that Arcari teaches a "weight" as taught by Applicant; (2) Applicant cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references; and (3) a non-floating beverage package is likely the product not of innovation but of ordinary skill and common sense;

With regard to the Examiner's first assertion, Applicant notes that claim 1 was amended to require that the weight be **realized from the group consisting of ceramic material, porcelain material, and naturally-occurring rock material. Claim 1 also requires that the weight cause the body portion to sink in water.** Ceramic, porcelain,

and naturally-occurring rock material are not dissolvable materials. As such, the "weight" of claim 1 requires such non-dissolvable materials. The "weight" of claim 1 must also cause the body portion to sink in water. The preferred embodiment of Applicant's specification supports this claim:

The weight 26 is formed from a non-toxic, insoluble odorless and flavorless material which is relatively more dense than water such that the infusion package 10 sinks when placed in water during steeping. Moreover, it is preferable that the weight 26 be microwave-compatible such that the package 10 can be placed into a cold cup of water that is heated by microwave radiation in a microwave oven without significant degradation. For example, ceramic or porcelain material or naturally occurring rock material (such as lava rock) may be used to form the microwave-compatible weight. See the Specification, page 7, line 17 to page 8, line 3.

In this preferred embodiment, the "sinking" weight is insoluble, and a dissolvable sweetener is carried by a third compartment. See page 8, lines 5-7 of the Specification. This embodiment supports and is clearly consistent with claim 1. It is only in an alternative embodiment that Applicant indicates that the weight may be dissolvable, but even then it still must be sufficiently dense to act like a weight and withstand dissolving long enough to keep the body portion immersed to allow for sufficient infusion of water into the infusion beverage product, aspects that are neither taught nor suggested by Arcari. Importantly, Arcari does not teach or suggest a weight that causes the body portion to sink in water, let alone a weight realized from ceramic, porcelain, and/or naturally-occurring rock material. Thus, the Examiner is clearly in error by suggesting that Arcari teaches a "weight" as taught and claimed by Applicant.

The Examiner's assertion with regard to Applicant individually attacking the cited references is not in line with *KSR International Co. v. Teleflex Inc. et al.*, 550 U.S. ___, 82 USPQ2d at 1396 (2007) or with the PTO's own guidelines. When considering the obviousness of a combination of known elements, the operative question is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* According to the *PTO Examination Guidelines*¹, the proper analysis required to reject the claims requires:

(1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;

(2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely would have performed the same function as it did separately;

(3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and

(4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

Therefore, Applicant can show that the proffered combination was not obvious at the time of the invention by attacking the references to show that the features of the references cited by the Examiner are not logically combinable because they are used to achieve different functions and/or are applied in a different manner in their respective

¹ *Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.*, Oct. 10, 2007, [Docket No.: PTO-P-2007-0031].

devices and/or that the references teach away from utilizing specific features. These arguments are asserted in Applicant's Appeal Brief and are further discussed below with regard to the Examiner's response to Applicant's arguments A.II. - A.IV.

Regarding the Examiner's assertion that independent claim 1 is obvious because a non-floating beverage package is likely the product not of innovation but of ordinary skill and common sense, Applicant submits that the anticipated success referred to by the Examiner is more than simply a "non-floating beverage package." The utility of Applicant's invention is realized through the combination of all of the elements of Applicant's claim, not just two of them. Moreover, as discussed in the Appeal Brief, the fact that the Examiner required four references to purportedly disclose the elements in Applicant's claim 1 despite tea bags having been around for nearly one hundred years speaks to the novelty of Applicant's invention. Taking the benefits of Applicant's invention and using those benefits to procure an obviousness rejection that requires four references to purportedly show the elements of the claim is not in the spirit of *KSR*.

Reply to Examiner's Response to Argument A.II.

In response to Applicant's argument that Kasket employs a weight as part of a beverage pack in a manner that teaches away from the claimed combination, the Examiner's Answer states that Kasket is merely being offered to show that the weight may be a non-toxic, water-insoluble substance, and not to show that the weight and infusion beverage product may be within the same porous body (because that limitation is shown in Arcari). However, *KSR* teaches that the operative question is "whether the

improvement is more than the predictable use of prior art elements according to their established functions," *Id.*, and the PTO's own guidelines require a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, that in combination, each element merely would have performed the same function as it did separately, and that one of ordinary skill in the art would have recognized that the results of the combination were predictable. *PTO Guidelines, (2) & (3)*.

Importantly, none of the cited prior art references teach or suggest a porous body that functions to carry both a weight made from ceramic, porcelain, and/or naturally-occurring rock material in addition to infusion beverage product. The weight made from ceramic, porcelain, and/or naturally-occurring rock material functions to sink the porous body in water, whereby it remains totally immersed therein during steeping. See page 9, lines 14-23 of the Specification. In Arcari, the porous compartments of the beverage pack function to carry infusion beverage product, milk and/or a sweetener. The porous compartments of Arcari do not carry a weight made from ceramic, porcelain, and/or naturally-occurring rock material for sinking the beverage pack as required by claim 1. In Kasket, the porous envelope of the beverage package functions to carry infusion beverage product. Thus, the porous envelope of Kasket does not carry a weight made from ceramic, porcelain, and/or naturally-occurring rock material for sinking the beverage pack as required by claim 1. For these reasons, the porous body of claim 1 employs a function (i.e., the carrying of a weight made from ceramic, porcelain, and/or naturally-occurring rock material for sinking the body portion of the beverage

package) that is not shown nor suggested in the cited prior art. Thus, rejection of claim 1 on grounds of obviousness is improper in light of the second part of the PTO Examination guidelines highlighted above.

The Examiner concocts a suggestion that the dissolvable sweetener of Arcari functions to sink the beverage pack of Arcari. Nowhere is this function described or suggested. Instead, Arcari states that the dissolvable sweetener functions to provide flavoring material that blends with the beverage. The Examiner subsequently asserts that the dissolvable sweetener of Arcari can be readily replaced by the metal weight of Kasket. This argument is clearly based upon improper hindsight reasoning and rests upon the false premise that Arcari employs a weight that causes the beverage pack to sink. Moreover, the beverage package of Kasket employs a porous envelope 6 carrying infusion beverage product and a non-porous pouch 7 carrying a metal weight. Thus, there is no teaching, suggestion, or motivation to combine the weight of Kasket into the porous body of Arcari as Arcari does not even disclose a weight that causes the body portion to sink.

Regarding the Examiner's claim in page 14 of the Answer that Applicant stated that Kasket teaches a weight in the form of wetted infusion material, Applicant has never made such a statement. Instead, Applicant pointed out in page 14 of the Appeal Brief that while the Examiner proposed that Kasket disclosed two kinds of weights, one of which purportedly formed from water contacting the infusion substances, in fact, Kasket teaches just the opposite, stating that without the weighted handle of Kasket, the beverage

package "would have a tendency to rise up in the cup due to captured air bubbles and the light density of the materials within the bag...thus preventing effective infusion of the beverage in the soluble base." While the Examiner may have withdrawn this assertion with respect to Kasket, he has made the same argument with respect to Arcari. But, as discussed above, the argument is invalid with respect to Arcari for the same reason that it is invalid with respect to Kasket.

Reply to Examiner's Response to Argument A.III.

In response to Applicant's argument that Kim discloses a fishing weight that is used in a manner that teaches away from the claimed combination, the Examiner's Answer states that Kim is offered for the express purpose of replacing the steel or nickel metal weight taught by Kasket with a non-toxic ceramic weight. However, the operative question is whether the improvement is more than the predictable use of prior art elements according to their established functions *KSR International Co. v. Teleflex Inc. et al.*, 550 U.S. ___, 82 USPQ2d at 1396 (2007). Applicant maintains the arguments set forth in the Appeal Brief, namely, that Kim discloses a mechanism that offsets the weight from a hook, that the functional purpose of the weight of Kim (allowing fishermen to cast their lures into the ocean) has nothing to do with Applicant's invention, and that the effect of the weight of Kim once the lure reaches the ocean is, in the standard practice of fishing, generally counterbalanced by a buoyant float so that the lure does not sink too far down in the water. Substituting the weight of Kim into the porous body of Arcari is more than the predictable use of prior art elements according to their established functions. In fact, Kim teaches away from the use, means of attachment, and function of the weight of

Applicant's invention, and does not teach or suggest anything remotely related to placing a weight in a porous compartment in conjunction with an infusion beverage product.

Reply to Examiner's Response to Argument A.IV.

In response to Applicant's argument that the "Tea Rock" weight is also used in a manner that teaches away from the claimed combination, the Examiner's Answer states that the Tea Rock is relied upon to teach that ceramic is well known in the art as a microwave safe material which is used as a weight for helping an infusion package sink, and that while the Tea Rock weight reference does not teach that the weight may be within the same porous body portion of an infusion beverage product, such a limitation is shown by Arcari. The operative question, however, is whether the improvement is more than the predictable use of prior art elements according to their established functions *KSR International Co. v. Teleflex Inc. et al.*, 550 U.S. ___, 82 USPQ2d at 1396 (2007). Again, Applicant submits that Arcari does not teach or suggest a porous body carrying a weight in addition to infusion beverage product, let alone a weight that causes the body portion to sink in water. The functional purpose of the Tea bag weight (to weigh down a tea bag) is not disclosed, taught, or suggested by Arcari. Applicant maintains that the Tea Rock teabag weight is attached externally to the teabag via a string that twists around a notch in the stone weight, that the weight is discardable, and that the weight is not contained within at least one porous compartment - all aspects of the Tea Rock weight that teach away from the limitations of claim 1, whose elements function together to produce a unique device not shown by the cited art.

In summary, it is not enough the Examiner has shown specific features of Applicant's invention in multiple references. It is the specific combination of elements and the means by which those elements are put together that give rise to the utility and definition of Applicant's invention. The features and limitations of claim 1 represent more than the predictable use of the prior art elements cited by the Examiner as the cited references teach away from each other, and, in combination, do not merely perform the same functions as they do separately.

Reply to Examiner's Response to Argument B.I

Applicant maintains that dependent claims 2-3 are patentable over the cited prior art for those reasons advanced above with respect to independent claim 1 from which they respectively depend.

Reply to Examiner's Response to Argument B.II.

Applicant refutes the Examiner's assertions that one cannot show non-obviousness by attacking references individually and that Arcari teaches an infusion beverage product and a weight based on the same arguments set forth above with respect to the Examiner's response to Arguments A.I. of Applicant's Appeal Brief.

Reply to Examiner's Response to Argument B.III.

Applicant maintains that dependent claim 5 is patentable over the cited prior art for those reasons advanced above with respect to independent claim 1 from which it depends.

Reply to Examiner's Response to Argument B.V.

Applicant maintains that dependent claims 11-15 are patentable over the cited prior art for those reasons advanced above with respect to independent claim 1 from which they respectfully depend.

Reply to Examiner's Response to Argument B.VI.

Applicant maintains the arguments set forth in the Appeal Brief with regard to claim 16, namely, that Rambold does not disclose, teach, or suggest carrying a weight in a bottom compartment that extends between the two body portions extending from a hinged interface, and that the functional improvements of providing increased steeping while also providing increased infusion surface area are not disclosed, taught, or suggested by Rambold.

Regarding the Examiner's assertion that Rambold is not used to teach the limitation of a weight in a bottom compartment because Arcari teaches this limitation, Applicant again submits that Arcari, as discussed above with respect to the Examiner's response to Argument A.I. of Applicant's Appeal Brief, does not teach a weight, let alone a weight in a bottom compartment that causes the body portion to sink in water.

Regarding the Examiner's assertion that one of ordinary skill in the art would have been motivated to "combine the teachings of Arcari and Rambold in order to produce a hinged area between two separate bodies where the two bodies are further separated by a

third body forming a bottom wall and containing a weight in order to cause the package to be more conducive to attaining the most advantageous rate of flow through the package and through the infusing substance thus allowing the same concentration of the beverage to be attained in a shorter amount of time" - Applicant maintains that these arguments constitute improper hindsight reasoning.

Reply to Examiner's Response to Argument B.VII.

Applicant maintains that dependent claims 17-19 are patentable over the cited prior art for those reasons advanced above with respect to independent claim 1 from which they respectfully depend.

In light of all of the above, it is submitted that the claims are in order for allowance, and the applicant respectfully requests that the Board direct the Examiner to allow the case.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jay P. Sbrollini". The signature is fluid and cursive, with a long horizontal stroke at the end.

Attorney for Applicant(s)
Jay P. Sbrollini
Reg. No. 36,266
Attorney for Applicant(s)

GORDON & JACOBSON, P.C.
60 Long Ridge Road
Suite 407
Stamford, CT 06902
voice: (203) 323-1800
September 19, 2008

IV. Claims Appendix

1. An infusion beverage package comprising:

a body portion comprising overlying layers of porous material that are joined to form at least one compartment, said at least one compartment carrying infusion beverage product in addition to a weight, said porous material of said at least one compartment allowing for passage of water therethrough for infusion of said infusion beverage product carried in said at least one compartment and said weight causing said body portion to sink in water, wherein said weight is realized from the group consisting of ceramic material, porcelain material, and naturally-occurring rock material.

2. An infusion beverage package according to claim 1, wherein:

said at least one compartment carries an agent that imparts flavor into a solution during steeping of said infusion beverage product.

3. An infusion beverage package according to claim 1, wherein:

said overlying layers of porous material are joined together by one of thermal welding, compression, folding or stitching to form said at least one compartment.

4. An infusion beverage package according to claim 1, wherein:

said at least one compartment comprises a first compartment distinct from a second compartment, said first compartment carrying infusion beverage product and said second compartment carrying said weight.

5. An infusion beverage package according to claim 1, wherein:

said weight comprises a material that is non-toxic, insoluble, odorless and flavorless.

6 - 9 (cancelled)

10. An infusion beverage package according to claim 1, wherein:

said porous material comprises a sheet of fibrous cellulosic material.

11. An infusion beverage package according to claim 1, wherein:

said porous material withstands immersion into boiling water without damage or disintegration in addition to being non-toxic, odorless and flavorless.

12. An infusion beverage package according to claim 2, wherein:

said agent is selected from the group consisting of sugar and a sugar substitute.

13. An infusion beverage package according to claim 1, further comprising:

a string having a first end opposite a second end, wherein the first end is anchored to said body portion; and

a tag affixed to said second end of said string.

14. An infusion beverage package according to claim 13, wherein:

said tag carries product indicia.

15. An infusion beverage package according to claim 1, further comprising:
two body portions that extend from a hinged interface.
16. An infusion beverage package according to claim 15, further comprising:
a bottom wall that extends between the two body portions, said bottom wall and
two body portions defining a space for solution to flow through during steeping, and
wherein said bottom wall has a compartment for carrying said weight.
17. An infusion beverage package according to claim 16, wherein:
said bottom wall is foldable.
18. An infusion beverage package according to claim 1, wherein:
said infusion beverage product is selected from the group consisting of tea and
coffee.
19. An infusion beverage package according to claim 1, wherein:
said infusion beverage product is selected from the group consisting of soups,
powdered milk, medicinal preparations, food seasonings, and dyes.